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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,064	11/06/2001	Martha A. Wild	SY01106KQB	1051

24265 7590 04/08/2003

SCHERING-PLOUGH CORPORATION  
PATENT DEPARTMENT (K-6-1, 1990)  
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EXAMINER

LUCAS, ZACHARIAH

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 04/08/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/994,064

Applicant(s)

WILD ET AL.

Examiner

Zachariah Lucas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 39-43 and 45-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 39-43, 45-47 and 49 is/are allowed.
- 6) ☒ Claim(s) 48 and 50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Status of the Claims***

1. Claims 39-43, and 45-50 are currently pending and under consideration in the application.
2. Claims 39-43, and 45-50 were rejected in the prior action, mailed on October 22, 2002. Claims 1-38, and 44 were withdrawn from consideration as to non-elected inventions in that prior action.
3. In the response filed by the Applicant on January 30, 2003, the applicant cancelled claims 1-38, and 44, and amended claims 39, 42, and 45-50. The applicant also filed Affidavits signed by the presently named inventors relating to the inventorship of a nucleic acid disclosed, but not claimed, in U.S. Patent 6,123,949.

### ***Information Disclosure Statement***

4. The Information disclosure statement filed February 15, 2002 indicates, in accordance with 37 CFR 1.98(a)(2), that copies of the references cited in the IDS may be found in the three parent applications to the present application. The Applicant's cooperation by sending in the missing IDS references is appreciated. The IDS has now been fully considered.

### ***Claim Rejections - 35 USC § 112***

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5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. **(Prior Rejection-Withdrawn)** Claims 39-43, and 45-50 were rejected in the prior action under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated nucleic acid molecule encoding an infectious laryngotracheitis virus (ILTV) glycoprotein D (gD) wherein the gD has the sequence disclosed as SEQ ID NO: 11 in the application, does not reasonably provide enablement for nucleic acids that encode any ILTV gDs. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. The claims have been narrowed in Amend. B such that they now read on nucleic acids encoding the particular protein disclosed as SEQ ID NO: 11. In view of this amendment, the rejection is hereby withdrawn.

7. **(Prior Rejection - Withdrawn)** Claim 39-43, and 45-50 were rejected in the prior action under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims are described above. They were rejected because, while the applicant has provided adequate written description for nucleic acids encoding for ILTV gD proteins with the sequence

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of SEQ ID NO: 11 in the application, there is no description for any nucleic acids encoding a ILTV gD protein that does not share the same sequence. The claims have been narrowed in Amend. B such that they now read on nucleic acids encoding the particular protein disclosed as SEQ ID NO: 11. In view of this amendment, the rejection is hereby withdrawn.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **(Prior Rejection -Withdrawn)** Claim 41 was rejected in the prior action under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This claim reads on a nucleic acid molecule that encodes for an ILTV gD wherein that nucleic acid molecule is a cDNA. The Examiner finds the Applicant's arguments in traversal of the rejection persuasive, and therefore, and hereby, withdraws the rejection.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **(Prior Rejection-Withdrawn)** Claims 39, 40, and 43 were rejected in the prior action under 35 U.S.C. 102(b) as being anticipated by Leib et al. (Avian Diseases, 30:835-837). These claims read, prior to Amend. B, on isolated nucleic acid molecules that encode for any infectious laryngotracheitis virus (ILTV) glycoprotein D (gD). The claims have now been amended such that they read on only nucleic acids encoding the specific gD identified as SEQ ID NO: 11. As the applicant's point out, the references do not disclose any gD ILTV protein. As different ILTV viruses have different gD protein sequences (see e.g., Johnson and Tyack, Vet. Microbiol. 46:221-231, at 225-26- disclosing a sequence for an ILTV glycoprotein D different from SEQ ID NO: 11), and as there is no indication as to the gD sequences of the virus disclosed in Leib, the rejection is withdrawn.

11. **(Prior Rejection- Withdrawn)** Claims 39, 40, 43, 45, 46, 48, and 49 were rejected in the prior action under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,123,949, issued to Cochran and Junker. The Affidavits under 37 CFR 1.132 filed on January 30, 2003 are sufficient to overcome the rejection of these claims. As the affidavits state that the presently named inventors are the inventors of the disclosed, but not claimed, material in the Cochran and Junker patent corresponding to the rejected claims, the rejection is hereby withdrawn.

12. **(Prior Rejection-Withdrawn)** Claims 39, 40, 43, 45- 47, and 50 were rejected in the prior action under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 5,928,648,

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issued to Cochran. The claims read on a nucleic acid encoding any ILTV gD, but have been amended such that they are now limited to nucleic acids encoding only the gD of SEQ ID NO:

11. In view of this amendment, and the fact that the reference does not identify any particular gD sequence, the rejection is withdrawn.

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **(Prior Rejection- Withdrawn)** Claims 41 and 42 were rejected in the prior action under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,123,949, issued to Cochran and Junker. The rejection of these claims is withdrawn in view of the Affidavits filed by the presently named inventors filed on January 30, 2003.

### ***Double Patenting***

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 48 and 50 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 47 and 49 of copending Application No. 09/993,777. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the co-pending patent encompass subject matter disclosed in that application that fall within the scope of the present claims. The claims of the co-pending application read on a recombinant DNA molecule encoding an ILTV glycoprotein I (gI), and an ILTV gD. The present claims read on a recombinant DAN encoding the ILTV gD of SEQ ID NO: 11, and an ILTV gI. In the specification of the copending application, the protein of SEQ ID NO: 11 is disclosed as an ILTV gD. See, SEQ ID NO: 11 of the copending application. Therefore, the presently claimed nucleic acids are obvious species of the genus claimed in application 09/993,777.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

17. Claims 39-43, 45-47, and 49 are found allowable.

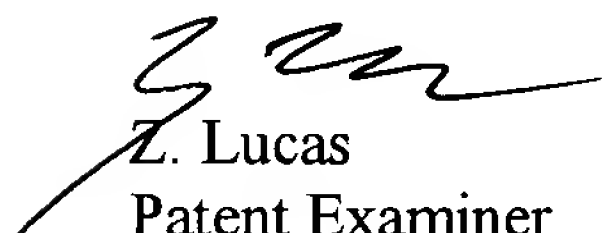



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18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachariah Lucas whose telephone number is 703-308-4240. The examiner can normally be reached on Monday-Friday, 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 703-308-4027. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
Z. Lucas  
Patent Examiner  
March 28, 2003

  
JAMES HOUSEL 4/7/03  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600